



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/931,492

08/16/2001

Thomas J. Colson

IPCP:107\_US\_

4008

24041

7590

12/15/2006

SIMPSON & SIMPSON, PLLC

5555 MAIN STREET

WILLIAMSVILLE, NY 14221-5406

EXAMINER

WINTER, JOHN M

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 12/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/931,492

Applicant(s)

COLSON ET AL.

Examiner

John M. Winter

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-11, 13-22, 24-33 and 35-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 2-11, 13-16, 19-22, 24-33, 35-38 and 41-44 is/are rejected.
- 7) ☒ Claim(s) 17, 18, 39 and 40 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 3621

### DETAILED ACTION

Claims 2-11, 13-22, 24-33 and 35-44 remain pending.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

#### *Response to Arguments*

The Applicants arguments filed on September 26, 2006 have been fully considered.

The Applicant states that Rivette does not teach the product document, the database or website as recited in claim 11.

The examiner responds that the term "product document" as specified in claim 11 is construed as any publication, notice, invoice or other material pertaining to the manufacture, usage, sale etc.. of a product. Rivette et al. discloses databases containing financial information, manufacturing information etc (Figure 2). The examiner contends that this is analogous to "product information.

The Applicant states the prior art fails to disclose a "publicly accessible web site"

The Examiner responds that this feature is disclosed by the Donner reference, Figure 2; column 5, lines 44-57 Donner discloses the usage of public databases such as DIALOG in order to retrieve product documentation.

The examiner contends that the Khan reference does disclose a product document in view of the above stated arguments.

The Applicant states that the Donner reference teaches against publication.

In response to Applicant's argument that there is no suggestion to combine the references, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969. In this case, .

The Hoke reference has been withdrawn.

See following rejection.

Art Unit: 3621

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-11, 13-16, 19-22, 24-33, 35-38, and 41-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al. (US Patent 6,339,767) in view of Donner (US Patent 6,154,725) in view of Hoke Jr. (US Patent 6,947,909) and further in view of Khan et al (US Patent 6,401,206).

As per claim 11

Rivette et al. ('767) discloses a method of publishing a product document, said method comprising the steps of:

providing a searchable document database and a publication Web site in communication with a document database;(Figures 2 and 3)

Rivette et al. ('767) does not explicitly disclose "electronically receiving said product document transmitted by a client's computer, and publishing said client document by adding said client document to said document database", Donner ('725) discloses "electronically receiving said product document transmitted by a client's computer,(Figure 1) and publishing said client document by adding said client document to said document database".(Figure 2) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Rivette et al. ('767) method with the Donner ('725) method in order in order to decrease the latency in document processing by utilizing electronic transmission means.

Examiner notes that the claimed feature of "wherein said publishing is for the purpose of disclosing information about a product to establish a bar to patentability of inventions practiced in said product" is directed towards intended usage of the method and does not constitute a patentable feature.

Rivette et al. ('767) does not explicitly disclose "Digitally notarizing said product document and obtaining a document notarization record, said document notarization record including a timestamp and a digital fingerprint", Khan et al. ('206) discloses digitally notarizing said product document and obtaining a document notarization record, said document notarization record including a timestamp and a digital fingerprint (Column 4, lines 45-63 [utilizes timestamp]; Abstract [discloses notary function] Figure 6, [digital fingerprint])

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Rivette et al. ('767) method with the Khan et al. ('206) method in order in order to decrease fraud by adding elements to verify authenticity such as time stamps.

Rivette et al. ('767) does not explicitly disclose "database is publically accessible", Donner ('725) discloses "database is publically accessible".(Figure 2; column 5, lines 44-57) It would have been obvious to one having ordinary skill in the art at the time the invention was

Art Unit: 3621

made to combine the Rivette et al. ('767) method with the Donner ('725) method in order in order to form an IP portfolio utilize materila in the public domain..

Claim 33 is in parallel with claim 11 and rejected for the same reasons.

As per claim 2,  
Rivette et al. ('767) discloses the method of claim 11,  
wherein said product document and one or more attachment files said product document comprises a primary document and one or more attached files.(Figure 2)

Claim 24 is in parallel with claim 2 and rejected for the same reasons.

As per claim 3,  
Rivette et al. ('767) discloses the method of claim 11,  
wherein said attachment files include a sample deposition statement.(Column 18, lines 28-30)

Claim 25 is in parallel with claim 3 and rejected for the same reasons.

As per claim 4,  
Rivette et al. ('767) discloses the method of claim 2,  
wherein said attachment files include an image of a sales brochure.(Figure 2)

Claim 26 is in parallel with claim 4 and rejected for the same reasons.

As per claim 5,  
Rivette et al. ('767) discloses the method of claim 2,  
wherein said attachment files include an image of a purchase order.(Figure 2)

Claim 27 is in parallel with claim 5 and rejected for the same reasons.

As per claim 6,  
Rivette et al. ('767) discloses the method of claim 2,  
wherein said attachment files include an image of a sales invoice.(Figure 2)

Claim 28 is in parallel with claim 6 and rejected for the same reasons.

As per claim 7,  
Rivette et al. ('767) discloses the method of claim 2,  
wherein said attachment files include an image of a commercial Web site page.(Figure 2)

Claim 29 is in parallel with claim 7 and rejected for the same reasons.

As per claim 8,

Art Unit: 3621

Rivette et al. ('767) discloses the method of claim 2,  
wherein said attachment files include an image of a printed advertisement.(Figure 2)  
Claim 30 is in parallel with claim 8 and rejected for the same reasons.

As per claim 9,  
Rivette et al. ('767) discloses the method of claim 2,  
wherein said attachment files include a video clip.(Column 26, lines 9-16; Figure 2)  
Claim 31 is in parallel with claim 9 and rejected for the same reasons.

As per claim 10,  
Rivette et al. ('767) discloses the method of claim 2,  
wherein said attachment files include an audio clip.(Column 26, lines 9-16; Figure 2)

Claim 32 is in parallel with claim 10 and rejected for the same reasons.

As per claim 13,  
Rivette et al. ('767) discloses the method of claim 11,  
Official Notice is taken that "obtaining a notarization record is performed by a  
notarization vender web site in communication with said database" is common and well known  
in prior art in reference to data management. It would have been obvious to one having ordinary  
skill in the art at the time the invention was made to utilize a web site in order to allow document  
retrieval from any site with Internet access.

Claim 35 is in parallel with claim 13 and rejected for the same reasons.

As per claim 14,  
Rivette et al. ('767) discloses the method of claim 11,  
Official Notice is taken that "charging said client a fee for adding said product document  
to said database" is common and well known in prior art in reference to data management. It  
would have been obvious to one having ordinary skill in the art at the time the invention was  
made to charge a fee for adding a document to the database in order to raise revenue to maintain  
the upkeep of the database

Claim 36 is in parallel with claim 14 and rejected for the same reasons.

As per claim 15,  
Rivette et al. ('767) discloses the method of claim 14,  
Official Notice is taken that "fee is paid before said product document is added to said  
database" is common and well known in prior art in reference to data management. It would  
have been obvious to one having ordinary skill in the art at the time the invention was made to  
charge a fee prior to adding a document to the database in order to raise revenue to maintain the  
upkeep of the database

Claim 37 is in parallel with claim 15 and rejected for the same reasons.

Art Unit: 3621

As per claim 16,  
Rivette et al. ('767) discloses the method of claim 11,  
further comprising the step of recording the number of times said product document is  
accessed by end users.(Column 36, lines 21-25)

Claim 38 is in parallel with claim 16 and rejected for the same reasons.

As per claim 19,  
Rivette et al. ('767) discloses the method of claim 11,  
further comprising the step of collecting and adding bibliographic data to said product  
document.(Column 18, lines 49-66)

Claim 41 is in parallel with claim 19 and rejected for the same reasons.

As per claim 20,  
Rivette et al. ('767) discloses the method of claim 11,  
wherein said product document is transmitted by said client's computer via one of a  
plurality of transfer protocols determined by said client.(Column 15, lines 2-3; Figure 3)  
Claim 42 is in parallel with claim 20 and rejected for the same reasons.

As per claim 21,  
Rivette et al. ('767) discloses the method of claim 20,  
wherein said plurality of transfer protocols includes the HTTP and FTP.(Column 15, lines  
2-3; Figure 3)

Claim 43 is in parallel with claim 21 and rejected for the same reasons.

As per claim 22,  
Rivette et al. ('767) discloses the method of claim 11,  
wherein said product document is published on a restricted basis for access only by users  
and user groups selected by said client.(Column 36, lines 27-38)

Claim 44 is in parallel with claim 22 and rejected for the same reasons.

***Allowable Subject Matter***

Claims 17, 18, 39 and 40 are objected to as being dependent upon a rejected base claim, but  
would be allowable if rewritten in independent form including all of the limitations of the base  
claim and any intervening claims and complying with double patenting statutes.

Any comments considered necessary by applicant must be submitted no later than the  
payment of the issue fee and, to avoid processing delays, should preferably accompany the issue  
fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for  
Allowance."

***Conclusion***

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Winter whose telephone number is (571) 272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



John Winter  
Patent Examiner -- 3621

KAMBIZ ABDI  
PRIMARY EXAMINER

